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### REMARKS

Claims 1-19 and 34-37 are pending in the present application. Claims 1, 13, and 17 have been amended to more precisely claim the invention, and do not narrow the scope of the claims. Claims 35 and 37 have been amended to place the claims in proper dependent form, leaving claims 1-19 and 34-37 for consideration upon entry of the present Amendment. Support for these amendments are found in the Specification and Claims as originally filed. No new matter is introduced by these amendments.

Per the Examiner's comment, Claims 20-33 have been indicated as "cancelled".

Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

### Response

Applicants appreciate the Examiner's careful consideration of the claims and the arguments previously presented, and the Examiner's detailed comments as to those arguments. Nonetheless, Applicants traverse the Examiner's continued rejection of claims 1-19 and 34-37 as obvious over Applicants' admissions either individually or in view of US 3839078 to Birchall et al. ("Birchall").

In particular, the Examiner maintains these rejections at least in part on the basis that Birchall "teaches that it has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers. . . . often referred to as 'anchor' coatings . . . ." such that "it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior art with an anchor layer . . . ." (Office Action, pp. 2-3.) The Examiner states that use of such a layer would have been "motivated by the desire to improve the adhesion between the laminate layers (emphasis added; citations omitted)." In view of the fact that there is clearly no need improve the adhesion between the laminate layers in the presently claimed flexographic tapes, Applicants respectfully disagree that the foregoing would have provided sufficient motivation to one of ordinary skill in the art. The two Declarations submitted in this case provide abundant evidence that failure to cleanly remove a polyurethane foam-containing flexographic tape is due to cohesive failure in the reinforcing layer, not bond failure between the foam and the reinforcing layer. Since an improvement in bonding strength is not needed in the manufacture of flexographic

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tapes comprising polyurethane foams, addition of an anchoring layer as suggested by the Examiner represents unnecessary expense and manufacturing time. One of ordinary skill in the art would therefore not have been motivated to provide flexographic tapes made using polyurethane foams with the anchoring layer of Birchall.

The Examiner also states that the admitted art and Birchall are in the same field of invention, i.e., an anchor coating to promote adhesion between a film substrate and superstrate. Applicants respectfully disagree with this characterization, as the present invention is directed to the problem of clean removal of a flexographic tape that suffers from cohesive failure of the reinforcing layer, not inadequate bond strength between the foam layer and the reinforcing layer. The fact that both Birchall and the present application refer to "anchor" layers does not mean that these layers have the same function.

As further motivation to combine the references, the Examiner states that "the idea of combining them flows logically from the prior art (MPEP § 2144.06)". This section of the MPEP cites law holding that "[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. . . . [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 U.S.P.Q. 1069, 1072 (C.C.P.A. 1980) Applicants contend that the anchor layers of Birchall are not used for the same purpose as the presently claimed anchor layers. *In re Kerkhoven* is therefore inapposite to the present claims.

With respect to the Examiner's contention that Applicants appear to be arguing the cited references individually, Applicants respectfully note that in determining whether claims are nonobvious under Section 103, the differences between the prior art and the claims must be determined. In this respect it is believed that the Examiner has used an improper standard in arriving at the rejection of the claims under Section 103, based on improper hindsight that fails to consider the totality of the invention and the totality of the cited references. In applying Section 103, the U.S. Court of Appeals for the Federal Circuit has consistently held that one must consider both the invention and the prior art "as a whole," not from improper hindsight gained

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from consideration of the claimed invention. See *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) and cases cited therein. According to the *Interconnect* court

[n]ot only must the claimed invention as a whole be evaluated, but so also must the references as a whole, so that their teachings are applied in the context of their significance to a technician at the time - a technician without our knowledge of the solution.

*Id.* Also critical to this Section 103 analysis is an understanding of the "particular results" achieved by the invention. *Id.*

The present claims are directed to a flexographic tape made using a polyurethane foam and a reinforcing layer. To further emphasize that the present article is directed to a flexographic tape, the independent claims have been amended to make this feature a claim limitation. The particular results achieved are that use of the claimed anchoring layer prevents cohesive failure of the reinforcing layer upon removal of the tape, at least to the extent that the tape can be removed as a unitary piece.<sup>1</sup> The anchor layers described in *Birchall* are used to improve bond strength between a substrate and a substrate, not to improve the cohesive strength of either the substrate or the superstrate. *Birchall* is further directed to "organic plastics films" and not polyurethane foams as is presently claimed. *Birchall* further fails to disclose the specific materials required in claims 20 and 22, for example. The specification and *Birchall* therefore do not provide any motivation to make the suggested combination, and no expectation of success if such combination were made. Furthermore, use of the anchor layers as described by *Birchall* are not an obvious optimization to one of ordinary skill in the art where improvement in bond strength between two layers is not needed.

In view of the foregoing, knowing particular results obtained by the present invention, the Examiner's selection and combination of the various aspects of the prior art is based on hindsight using the present claims as a blueprint. *Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d

<sup>1</sup> With respect to these particular results, the Examiner has stated that Applicant's arguments regarding inherency are not persuasive since it assumes that an anticipation rejection, not an obviousness rejection, has been made. Applicants recognize this distinction, and agree that inherency should not be used in making a rejection under Section 103. The courts have repeatedly made the distinction that "[t]hat which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown." *In re Spormann*, 363 F.2d 444, 448, 150 U.S.P.Q. 449, 452, (C.C.P.A. 1966), citing *In re Adams*, 356 F.2d 998, 148 U.S.P.Q. 742 (C.C.P.A. 1966).

Note, however, that the Examiner then states in the next sentence that "the properties of the instantly claimed invention are believed to be either inherently disclosed or an obvious optimization to one of ordinary skill in the art of anchoring layer." (Office Action, p. 4). Applicants therefore request clarification of whether or not the Examiner is

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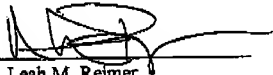
289 F.3d 1367, 1376, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002) ("[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention"). It is therefore requested that the Examiner reverse the present rejections and allow the claims.

It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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relying on inherency in the instant rejections.